

Appl. No. 10/712,436
Amdt. dated November 17, 2004
Reply to Office action of October 19, 2004

Docket No. 58298-011501

ELECTION/RESTRICTION**REMARKS / ARGUMENTS**

Restriction has been required to one of the following inventions under 35 U.S.C. § 121: Group I is claims 1-5 drawn to a marking template, classified in Class 606, subclass 96. Group II is claim 6-15, drawn to a method of making a marking template, classified in Class 128, subclass 898. Group III is claims 16-19, drawn to a method of installing the device, classified in Class 623, subclass 20.35.

In response to the Restriction Requirement, Applicants hereby elect the invention of Group II, claims 6-15, for prosecution on the merits with traverse.

Claims 1-19 are currently pending in the above-identified application and, pending the outcome of the traversal of the restriction requirement, are still pending in this case.

The Restriction Requirement states that inventions of Group I and II are related as process of making and product made. The Examiner states that these groups are distinct because the product as claimed can be made by a materially different process, such as casting (Page 2 of Office Action of 10/19/2004). Applicants respectfully point out that casting is an exemplary method for practicing the methods of the invention, and indeed, Claim 6 clearly recites the step of "...pouring viscous material into the second mold to make a replacement device". This is casting and as such, the Examiner has failed to recite and provide a materially different process other than what is disclosed in the application, i.e. a materially different process for making a claimed product, for example, a replacement device. Thus, this restriction should be withdrawn and at least the claims of this group be examined together.

The Examiner has stated that the Inventions of Group I and III are related as product and process of use and that they are distinct because the process as claimed can be practiced without the step of compiling in a computer CT image data of the patient's distal end of the femur. However, the claims of group I and III recite no such limitation, so the basis of such a restriction is unclear. Therefore, this restriction should also be withdrawn and at least the claims of these two groups should be examined together.

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In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call Applicants' undersigned representatives, attention Claude Nassif, Ph.D., at (310) 586-7828 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred to when charging any payments or credits for this case.

Respectfully submitted,

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